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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,523	09/15/2000	Veronique Roulier	6388-0518-0	9437

22850 7590 07/22/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/22/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/555,523

Applicant(s)

ROULIER ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13, 15-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15-29, 34-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>20</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1-10, 12-13, 15-32, 34-46 are pending. Claims 12-13, 30-32 are withdrawn from consideration, as they are directed toward non-elected subject matter. The Amendment filed 6/17/03, Paper No. 19, amended claims 1 and 20.

Applicant's arguments are persuasive to over the 35 USC 112 rejection in the previous Office Action.

103 Rejection Maintained

The rejection of claims 1-10, 15-29, 34-46 under 35 U.S.C. 103(a) as being unpatentable over JP 09255529 (translation) in combination with US 5,326,484 is MAINTAINED for the reasons set forth in the Office Action mailed 3/17/03, Paper No. 18, and those found below.

Applicant argues, "The claimed invention requires the fatty substances in the oily phase to consist essentially of oils. For purposes of the claimed invention, oils differ from solid fatty substances such as waxes. JP '529 neither teaches nor suggests this limitation". This argument is not persuasive. The Examiner respectfully points out that for the purposes of searching for and applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. See MPEP 2111.03.

Applicant argues, "JP '529 teaches away from O/W emulsions in which the oily phase consists essentially of oils. Specifically, JP '529 states that the oily phase of its compositions

Art Unit: 1617

must be solid. . .Moreover, JP '529's comparative example 2 demonstrates that compositions containing an oily phase lacking fatty substances are unacceptable and, thus, that substantial amounts of solid fatty substances must be present". This argument is not persuasive. First, the Examiner respectfully directs Applicant to the above paragraph, regarding the phrase "consisting essentially of". Second, the Examiner respectfully points out that JP '529 teaches oils in their oils phase. See Claim 6 of JP '529 which teaches higher alcohols and higher fatty acids as oil components and see page 21 of JP '529 which teaches that liquid fats and oils can be blended into the emulsion. The Examiner respectfully points out that oils can be in both solid and liquid forms based on their chemical make-up and the temperature at which they are contained. However, Applicant has not claimed the oils in a liquid state.

Applicant argues, "nothing in Nakashima would motivate one skilled in the art to modify JP '529, contrary to the teachings of JP '529, such that the fatty substances in the oily phase consist essentially of oils". This argument is not persuasive, as Nakashima is merely relied upon to teach monodispersions.

Applicant argues, "no motivation would exist to combine JP '529 and Nakashima with the expectation that a stable emulsion containing monodispersed globules would be obtained". This argument is not persuasive. Nakashima is specifically directed toward emulsions comprising little or no surfactants and JP '529 is an emulsion with substantially no surfactant, and Nakashima teaches that great stability is imparted to such emulsions when the oily globules of the oil phase are monodispersed. Thus, there is motivation to combine the two references.

Art Unit: 1617

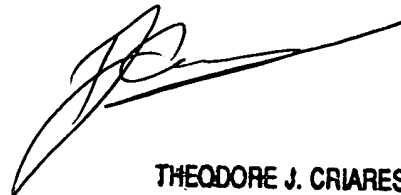
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
July 18, 2003



THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200
/600